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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,018	05/29/2001	Neil Roberts	ST 98027	1295

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EXAMINER	
GITOMER, RALPH J	

ART UNIT	PAPER NUMBER
1651	

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/763,018	ROBERTS ET AL.	
	Examiner	Art Unit	
	Ralph Gitomer	1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 February 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *9-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *9-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The amendment received 2/25/2004 has been entered and claims 9-18 are currently pending in this application.

The rejections of record under 35 USC 112, second paragraph is hereby withdrawn in view of the amendments to the claims and arguments presented.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:
(1) if a machine or apparatus, its organization and operation;
(2) if an article, its method of making;
(3) if a chemical compound, its identity and use;
(4) if a mixture, its ingredients;
(5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given. The abstract as presented is in non-standard format.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9, 10, 11, 13, 14, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Sabatier.

Sabatier (J of Applied Poultry Res) entitled "Method of Analysis for Feed Enzymes" teaches on page 411, column 1, the measurement of dye release from a defined substrate coupled to a dye (substrate chromophore) works on specified substrates. The analysis consists of a measurement of the release of the chromophore in a defined time interval under specified conditions. On page 412 Table 4 various buffers are shown.

All the features of the claims are taught by Sabatier for the same function as claimed.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sabatier.

See the teachings of Sabatier above.

Claim 16 differs from Sabatier in that it recites there are two phases that are separated.

It would have been obvious to one of ordinary skill in this art at the time the invention was made in view of the teachings of Sabatier to create a liquid phase and separate any solids prior to determining because the feeds of Sabatier are solids that are dissolved in liquids and solids remaining are known to interfere with light based measurements. The separation of liquid and solids in determinations where one is known to interfere with the other is old in this art.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sabatier as applied to claim 16 above, in further in view of Turner.

The teachings of Sabatier are found above.

The claim differs from Sabatier in it recites the reagent is in the form of a solid bead.

Turner (6,001,587) entitled "Chemically Specific Patterning on Sold Surfaces Using Surface Immobilized Enzymes" teaches in the abstract, substrates may be immobilized on various surfaces. In column 1 lines 33-38, immobilized enzyme substrates are well known. In many places in the document, particles of various types, sizes, and shapes are shown including beads.

It would have been obvious to one of ordinary skill in this art at the time the invention as made to employ the beads of Turner in the method of Sabatier because immobilizing any desired substrate to perform a reaction with the expected result is old in this art as taught by Turner. No unexpected results are seen in the claimed immobilized substrate.

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sabatier as applied to claim 16 above, and further in view of Bio-Red Labs.

The teachings of Sabatier are found above.

The claims differ from Sabatier in that they recite special features of the container.

See the teachings of Bio-Red Labs in the Office Action of 10/25/2002.

It would have been obvious to one of ordinary skill in this art at the time the invention as made to employ the container of Bio-Rad Labs in the method of Sabatier because the container is a standard column container and known to be well suited to combining and reacting components.

Applicant's arguments filed 2/25/04 have been fully considered but they are not persuasive.

Applicants state the references of record to not disclose or suggest the invention and that Turner is properly combinable with Sabatier.

It is the examiner's position that the references cited of record above do fairly suggest or teach the invention as claimed. No reasons are set forth to dispute this.

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art at the time the invention was made. See In re Keller 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

The references are combined because Sabatier does not teach the reagent in the form of a solid bead and to employ beads is well known in this art and would have the same function as claimed as described by Turner. No unexpected results are seen.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Heil (Zootecnica Int) teaches assay of enzyme activity in feeds.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ralph Gitomer whose telephone number is (571) 272-0916. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on (571) 272-0926. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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